

### **REMARKS**

In the March 28, 2003 Office Action, the Examiner rejected claims 1-39 pending in the application. Upon entry of the foregoing amendments, Applicants amend claims 1-4, 7, 15, 19, 21, 23, 26-28, 32-34, and 37, cancel claims 17 and 18 without prejudice or disclaimer, and add new claims 40-46 for consideration. Support for the amended claims and the new claims may be found in the originally filed specification, and thus, no new matter is added by this amendment. Upon entry of the foregoing amendments, claims 1-16 and 19-46 (5 independent claims; 44 total claims) remain pending in the application. Applicants request reconsideration in view of the above amendments and the following remarks.

### **TELEPHONIC INTERVIEW**

In the telephone interview of May 14, 2003, the Examiner and the Applicants' representatives, David O. Caplan and Howard I. Sobelman, discussed the Office Action of March 28, 2003, the Noblett Jr. reference (U.S. Patent No. 5,432,326), the Collins reference (U.S. Patent Application Publication No. 2002/0007362 A1), and proposed amendments to the claims. As discussed during the interview, Applicants maintained that Applicants' invention is patentable over the cited prior art. Agreement with respect to the claims was reached as follows. Applicants agreed to amend the independent claims to change "pre-existing forms" to "available forms." The Examiner agreed that this amendment would overcome the 35 U.S.C. §112, first paragraph rejection in the Office Action. Accordingly, Applicant has amended independent claims 1, 7, 15, 23, and 33 to recite "available" instead of "pre-existing" as discussed with the Examiner.

### **In the Claims**

### **Claim Rejections**

### **35 U.S.C. §112**

Claims 1-39 stand rejected under 35 U.S.C. §112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." In particular, the

Examiner stated "the inventive concept such as '*pre-existing ... having pre-defined content*' described in claims 1, 7, 15, 23 and 33 are not disclosed in the specification." Applicants respectfully traverse this rejection.

As discussed with the Examiner in the telephone interview of May 14, 2003, amending independent claims 1, 7, 15, 23 and 33 to recite "available" instead of "pre-existing" would be sufficient to overcome this rejection. The claim element "available dispute handling forms having pre-defined content" are disclosed in the specification as originally filed. For example, with reference to P. 4, lines 3-5, the specification states "a plurality of dispute resolution forms is stored in a central server." The "stored" dispute resolution forms refer to "available" dispute handling forms that are stored in the central server as described on P. 4 of the specification. In addition, with reference to P. 11 of the specification, lines 2-3 state "AP can access the forms **available** to an Issuer or an Acquirer and **complete** the forms on behalf of and at the direction of the Issuer or Acquirer." (emphasis added) This statement, among others, refer to "available forms" having "pre-defined content" as the AP completes the forms. Another example of the forms having "pre-defined content" is found on P. 19, lines 10-12, where the specification states the program retrieves the forms "and **populates** the identical field entries that were entered by the previous end-user." (emphasis added)

For the above reasons, Applicants submit that claims 1-16 and 19-46 are in conformance with 35 U.S.C. §112, first paragraph, and Applicants respectfully request withdrawal of the rejection of claims 1-16 and 19-39 under 35 U.S.C. §112, first paragraph.

### **35 U.S.C. § 103**

Claims 1-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noblett Jr. et al, U.S. Patent No. 5,432,326, issued July 11, 1995 (hereinafter "Noblett"), in view of Collins et al., U.S. Patent Application Publication No. 2002/0007362 A1, published January 17, 2002 (hereinafter "Collins"). Applicants respectfully traverse this rejection and provide the following arguments in support.

Noblett discloses an authorization system for use during a transaction such that the system provides chargeback protection services for the benefit of the merchant.

Collins discloses a system that acts as a **third party** to produce an agreement for resolving a dispute between two parties. In contrast to Noblett and Collins, the presently claimed invention provides for a significantly different system and method that **facilitates "communication** between an Issuer and an Acquirer in the context of resolving a post-transactional dispute." That is, the presently claimed invention does not provide for a system or method that includes direct participation in the dispute resolution. For example, when a post-transaction dispute arises between an Issuer and an Acquirer, the presently claimed invention provides for a system and method that display a pre-defined set of available forms to the Issuer. The Issuer selects one of the available forms and completes the selected form. The Issuer then sends the form to the Acquirer who views the form. The Acquirer then selects a form from a display of a pre-defined set of forms and also completes the selected form. This process may be repeated for a number of forms.

In contrast, Collins provides for a significantly different system. For example, when a dispute arises between two parties, Collins provides a system that allows the two parties to log in and enter information about the dispute that is sent to the central server and is not shared directly with the other party (for example, see paragraph 0042 of Collins). The system of Collins then uses the entered information to generate a proposed agreement that may be used to resolve the dispute (see paragraph 0042). In contrast to the presently claimed invention, the system of Collins does not provide for the selection of a form, by a person, from a display of a pre-defined set of available forms. Significantly, the use of the term "form" in paragraph 0043 of Collins refers to a different "form" than that utilized by the present invention. That is, the "form" or "template" of paragraph 0043 of Collins refers to the external appearance of the presentation of various data fields and does not refer to a document with blank spaces to be filled in with information. In addition, in contrast to Collins, the presently claimed invention provides for an Issuer and an Acquirer such that the Issuer issues "transaction card to the card member under a cardmember agreement for a cardmember account" and the service establishment accepts the "transaction card under terms previously agreed to with the Acquirer."

### **Noblett Reference**

Noblett discloses a specific system for operating a data card terminal for providing chargeback protection services for the benefit of the merchant. In particular, Noblett discloses a custom data card transaction terminal having a signature capturing printer. The Noblett custom data card transaction terminal does not include similar components or functions as an internet access terminal. Merchants using the custom terminal with the signature capturing printer are guaranteed that the transaction is chargeback-protected. (Noblett Abstract; Summary of the Invention (see e.g., col. 14)) In other words, Noblett discloses a **pre-transactional** system that when used by a merchant to carry-out a data card transaction (i.e., using the custom terminal and capturing the purchaser's signature during the time of purchase), the merchant is guaranteed that the transaction will not be charged-back to them.

In operation, a merchant using the custom terminal and signature capturing printer obtains the customer's signature at the time of the purchase, and particularly, before the credit transaction is executed. The signature as well as other transaction data (e.g., including compressed signature signals and signals indicative of the presence of the card; (Noblett Abstract)) are stored in a data storage facility and may be retrieved for future reference or evidence of a transaction. (Noblett column 22, lines 7-9; Figure 2 (data storage #64)) In addition to the data storage facility, the custom transaction terminal stores all the transaction data, except the signature.

The Noblett reference teaches away from the presently claimed invention. The system disclosed in Noblett does not include any hardware or software to facilitate communication during post-transactional disputes because, the Noblett system is an authorization system, and not a post-transaction dispute resolution system. Post-transactional disputes are prevented and guaranteed against. In addition, Noblett does not disclose facilitating communication to resolve a dispute or prevent a dispute because (1) there are NO post-transactional disputes in Noblett since using the custom data card terminal *guarantees* the merchant will not be involved in a post-transactional dispute, therefore there is no need to negotiate an agreement to resolve a dispute; and (2) the Noblett system discloses using a custom *data card terminal*, i.e., a specific device to read the user's data card, to prevent disputes, and not a system to facilitate

communication to resolve post-transaction disputes. There is no mention of facilitating communication to resolve a dispute at *any* time during the transaction because that is simply NOT analogous to the objects of invention Noblett sets forth (using a custom data card terminal to guarantee against merchant chargebacks). As such, Noblett does not disclose, *inter alia*, "a system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute regarding a pre-existing charge, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a service establishment."

### **Collins Reference**

Collins discloses a specific third party system for automatically generating an agreement pertaining to a situation over a network. "Situation" as used in Collins refers to "a dispute" or "the negotiation of an agreement." (Collins paragraph 37) In operation, the parties in a dispute engage in a negotiation session with a third party to resolve the situation. For example, party A initiates a negotiation session by connecting to the central server 120 and describing the nature of the situation, including the identity of party B. Party B is then contacted by the central server 120 and asked to engage in the negotiation. Both parties then enter information defining the situation and provide their desired resolutions. *"Based on the data provided, the server generates a zone of possible agreements (ZOPA) 130, and the data is rendered as a set of components in a template."* (Collins paragraph 42) The template includes components showing possible resolutions to the positions of the parties. The central server generates these components by accessing a database 140 which contains statistical information concerning acceptable resolutions previously agreed to by other parties involved in similar situations. Each party then responds back to the server 120 by providing additional data and *based on this data, the server creates a new ZOPA template.* "After an iterative process [as just described], a resolution is reached or a negotiation log is finalized for presentation to a mediator." (Collins paragraph 42) The ZOPA for an individual issue serves as the guideline for resolution of that issue and results in a tentative agreement contingent on the whole (TACOW). The TACOWs are refined and

combined into a total agreement or binding agreement which may further include generation of a written contract which each party can print. (Collins paragraphs 46 and 52)

**With respect to independent claims 1, 7, 15, 23, and 33,** the Examiner states that Noblett discloses each element as recited in the claim except "Noblett fails to teach an inventive concept for facilitating the handling of a post-transactional dispute" and cites Collins to fill in this deficiency. Furthermore, the Examiner states that it would have been obvious to modify the Noblett disclosure (a custom data card terminal used to guarantee against merchant chargebacks) to include the Collins disclosure (a system for negotiating and creating a resolution agreement) because "statistical data pertaining to previous resolutions may be useful in aiding resolution of present and future situations." The Applicants respectfully disagree with the Examiner.

All the claimed limitations are not taught or suggested by Noblett either alone or in combination with Collins. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *MPEP 2143.03 citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).*

There is no suggestion or motivation to combine the Noblett and Collins teachings. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *MPEP 2143.01 citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).* Applicants submit that neither the cited references, alone or in combination, suggest the desirability of the combination of the Noblett and Collins references. That is, there is no motivation to combine the authorization system of Noblett with the automatic agreement generation system of Collins because Noblett teaches away from resolving post-transaction disputes. As previously mentioned, Noblett fails to suggest a negotiating system for generating a resolution agreement because (1) there is no need to resolve a post-transactional dispute since they are prevented; and (2) Noblett is not a negotiating system but rather is a specific device used to authorize transactions. Noblett only discloses improving upon *facilitating data card transactions* which does not include negotiating, generating and mediating an agreement.

Applicants submit that even if the combination of Noblett and Collins were made as suggested by the Examiner, Applicants' claimed invention would not result. In particular, Applicants' amended independent claim 1 (and amended independent claims 7, 15, 23 and 33) recites "a system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute regarding a pre-existing charge, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a service establishment." (emphasis added) In addition, Applicants' amended independent claim 1 (and amended independent claims 7, 15, 23 and 33) recites "the Issuer selects one of the available forms utilizing said input means." (emphasis added) As previously pointed out above, Noblett discloses an authorization system that is not a system for facilitating communication during a post-transactional dispute. Noblett fails to disclose, teach or suggest, *inter alia*, a "system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute regarding a pre-existing charge, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a service establishment" and wherein "the Issuer selects one of the available forms utilizing said input means." There are NO post-transactional disputes whatsoever in the Noblett system because Noblett discloses a *data card terminal* that is used as an authorization system and not a dispute resolution system.

Moreover, Collins fails to teach, suggest or disclose these elements. As previously pointed out, Collins discloses a negotiation process facilitated by a third party whereby each party is given an opportunity to define the situation and provide their desired resolutions to a third party. Based on the data provided, the server generates or creates a ZOPA which will be used as a guideline for resolving the issue. Collins does not include "facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute regarding a pre-existing charge, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a service establishment" and Collins does not include a system wherein "the Issuer selects one of the available forms utilizing said input means." Rather, Collins is used to generate an agreement for

a dispute between a consumer and a merchant over price (for example, see P. 3 paragraph 0039 and P. 6, paragraph 0053). Collins may also be used to generate an agreement for a dispute between a customer and the issuer of a credit card. In this situation, the customer is disputing a purchase transaction appearing on a credit card statement (for example, see P. 3 paragraph 0039). In other words, Collins is used to facilitate resolution in situations where there is a dispute over "price" or over a "purchase transaction" on a credit card statement. In contrast, amended independent claim 1 (and amended independent claims 7, 15, 23 and 33) provides for a "a system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute regarding a pre-existing charge, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a service establishment." (emphasis added)

In addition, Applicants submit that the combination of Noblett and Collins do not disclose, teach or suggest each and every element of new dependent claims 40-46. In particular, new dependent claims 40, 41, 43, and 45 recite "said Issuer enters transaction specific information" wherein said transaction specific information includes "a transaction number for said executed credit transaction, a cardmember account number for said transaction card, and a service establishment identifier for said service establishment." Such elements are not disclosed by the authorization system of Noblett or the automatic agreement generation system of Collins. In addition, new dependent claims 42, 44, and 46 recite "subjectively selecting, by a human operator, a particular one of a pre-defined set of said first user forms based on a subjective assessment of the dispute." (emphasis added) Neither Noblett or Collins discloses singly, or in combination, this element.

**With respect to dependent claims 2-6, 8-14, 16, 19-22, 24-32 and 34-46,** Applicants submit that all of the elements of the underlying independent claims 1, 7, 15, 23 and 33 are not present in the cited references either alone or in combination, and therefore are not present in claims 2-6, 8-14, 16, 19-22, 24-32 and 34-46. In addition, new dependent claims 40-46 are not present in the cited references either alone or in combination, for the additional reasons set forth above. Accordingly, Applicants



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respectfully request the withdrawal of the Section 103 rejection with respect to claims 1-39.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 1-46, fully comply with 35 U.S.C §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience.

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Respectfully submitted,

By: David O. Caplan  
David O. Caplan  
Reg. No. 41,655

**SNELL & WILMER, LLP.**  
One Arizona Center  
400 East Van Buren  
Phoenix, AZ 85004-2202  
Direct: (602) 382-6284  
Fax: (602) 382-6070  
Email: [dcaplan@swlaw.com](mailto:dcaplan@swlaw.com)